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REMARKS

Claims 1-16 remain pending in the application.

Applicant respectfully requests reconsideration and examination of Claims 1-16 in view of the arguments below.

By way of this response, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the examiner telephone Timothy R. Croll at (408)433-7625 so that such issues may be resolved as expeditiously as possible.

Response to the rejection under 35 U.S.C. § 102

Claims 1-16 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Lin et al., IEEE, October 2003, pp. 17-25 (Lin). Applicant overcomes the rejection as follows.

As attested to in the attached Declaration under 37 C.F.R. § 1.131, Applicants are the co-inventors of the invention disclosed and claimed in the subject application; Applicants described the invention in the attached paper titled "TRANSITION DELAY FAULTS AND STUCK-AT FAULTS TEST PATTERNS GENERATION FLOW" and disclosed the invention in the attached invention disclosure submitted to LSI Logic Corporation for "TRANSITION DELAY FAULT EFFICIENT PATTERN GENERATION FLOW TO ADDRESS HIGH SCAN DATA VOLUME" before the effective date of October 2003 of the publication "High-Frequency, At-Speed Scan Testing" by Lin, et al.; and Applicants conceived the invention in the United States of America.

As evidenced by the attached copy of the LSI Intellectual Property Law Department Memo, the inventors were granted an award on September 12, 2003 for submitting the disclosure for the invention disclosed and claimed in the

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subject application. On October 10, 2003, the disclosure was forwarded to the undersigned with an authorization for preparation of a patent application.

In accordance with customary practice, the subject matter of the claimed invention was prepared by the undersigned in a first draft patent application and sent to the inventors for review on October 20, 2003, as evidenced by the attached copy of the forwarding letter. The inventors reviewed the first draft and forwarded their comments to the undersigned. After receiving comments from the inventors, the final draft and formal drawings were prepared and forwarded to the inventors with execution documents on November 24, 2003, as evidenced by the attached copy of the forwarding letter. Upon receiving the executed documents from the inventors, the patent application was filed on December 3, 2003.

Further, the contributions from co-inventors Cam L. Lu and Robert B. Benware are acknowledged in *Lin* on page 24.

No additional fee is believed due for this amendment.

Respectfully submitted,



Eric James Whitesell

Reg. No. 38,657

encl:

- (1) declaration of CAM L. LU, ROBERT B. BENWARE and THAI M. NGUYEN;
- (2) copy of invention disclosure docket number 03-1978;
- (3) copy of paper titled "TRANSITION DELAY FAULTS AND STUCK-AT FAULTS TEST PATTERNS GENERATION FLOW";
- (4) copy of LSI Intellectual Property Law Department Memo dated October 2, 2003;

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- (5) copy of letter forwarding first draft on October 20, 2003; and
- (6) copy of letter forwarding final draft on November 24, 2003.

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